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Attorney Docket No. 48,742 CPA (70904)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

#24

K DAVIS  
11-4-03

APPLICANT: H. Maeda, et al. EXAMINER: Wallerson, Mark E.  
U.S.S.N.: 09/185,212 GROUP: 2622  
FILED: November 3, 1998  
FOR: IMAGE PROCESSING DEVICE INCLUDING IMAGE DATA  
MANAGEMENT CAPABILITIES (AS AMENDED)

**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Mail Stop: Appeal Brief - Reply to Examiner's Answer, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 2, 2003.

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Sir:

**APPLICANTS' REPLY TO EXAMINER'S ANSWER**

This is in reply to the Examiner's Answer filed in this Appeal on 12 August 2003 (paper No. 23).

Three copies of this REPLY TO EXAMINER'S ANSWER are enclosed.

No further fees are believed to be due in connection with this REPLY TO EXAMINER'S ANSWER. If, however, for any reason any further fees are required, any fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit such amounts to Deposit Account No. **04-1105**, as necessary.

### **I. INTRODUCTION**

Applicants respectfully submit that the Examiner's Answer, and particularly the Response to Argument section thereof, is indicative of the technically, and/or legally, erroneous bases of the currently outstanding rejections of the pending claims of this application. In this Reply to the Examiner's Answer, however, without prejudice to any of the arguments presented in its Brief on Appeal or otherwise in the record of this application, Applicants will not belabor the present record by restating their position(s) in response to each and every facet of the Examiner's restatement of his Final Rejections of the currently pending claims of this application and/or argument in response to Applicants' Brief on Appeal. Instead, Applicants will limit this Reply to the Examiner's Answer to pointing out and rebutting only the key erroneous features of the Examiner's position against the patentability of the presently pending claims of this application.

## **II. DISCUSSION**

- A. ***The pre sent disclosure definitively supports the facts (i) that in the presently pending claims the phrase "each input image data" refers to sub-images when considered in the context of images of entire pages, and (ii) that "each input image data" (i.e., each sub-image) is separately subjected to an input request, an input completion request and a processing completion request.***

Significantly, the Examiner has admitted that the Summary of the Invention contained in Applicants' Brief is correct (see page 3 of Examiner's Answer). Since Applicants clearly and distinctly emphasized in the Summary of the Invention portion of their Brief that both the image input and the data management table function on an **"each input image data" basis** with appropriate supporting citations to the specification of the present application, the Examiner's admission appears to concede that the terminology "each input image data" used in the currently pending claims when considered in the context of images of entire pages means sub-images of those entire page images.

Nevertheless, in an apparent attempt to avoid the logical consequence of the admission just referred to, the Examiner in his Answer also contends (**for the first time**, as far as Applicants have been able to determine) that a construction of the phrase "each input image" of the present application to mean that each image of a page is "broken up" according to the type of image (for example, text, graphics or images), and then each of those individual images are managed by the management table is not supported by the present specification (see sentence bridging pages 12-13 of Examiner's Answer). Applicants respectfully submit that the problem with the Examiner's argument in this regard is that it artificially imposes limitations on the phrase "each input image" that are nowhere contemplated or stated in the present specification.

Applicants, therefore, respectfully contend that the Examiner's mischaracterization of Applicant's position in the above regard dodges the true issue of what is meant in the present specification and claims of this application by the phrase "each input image".

More specifically, Applicants agree that there is no specific support in the specification for the "breaking up" of an entire page image into sets of individual images, each a of different content type *per se*. Applicants respectfully submit, however, there is clear and unequivocal support in the specification for Applicants' position that the present invention contemplates that when considered from the perspective of a so-called "page image", the present invention teaches that the input image data is to be input and managed in the form of a plurality of component sub-page-images. In this regard, attention is respectfully directed to the last full sentence of page 42 of the present specification that is quoted at page 9 of Applicants' Brief and reads as follows:

"The input completion information 708 shows whether image data of one page is completely inputted from the image input section (whether the image data is stored in the image memories 403 and 502."

Hence, it will be understood that the image completion information 708 of the management table 701 shows whether or not the image data (i.e., all of the "each input data" component parts of a so-called "page image") has been **completely inputted** into the image memories 403 and 502. There is no doubt that this conclusion is correct because it is fully supported by the context in which the last quoted statement was made in the present specification. Specifically, the two quotes from page 41 of the present specification set forth at page 9 of Applicants' Brief support this conclusion, as does the sentence appearing at line 9-12 of page 42 of the present specification that reads as follows:

**"The read image number information 706 indicates how many images are inputted as the image data of one page through an input section such as the scanner section 204(31)."** (Emphasis added)

Therefore, the explanation contained in the present specification of the image data of one page being completely inputted can only refer to whether all of the separate, individual images (i.e., "each input image data") contemplated as making up the entire so-called "page image" have been inputted.

Consequently, Applicants respectfully submit that the Examiner's assertion that the present specification does not support the construction of the term "each input image" as meaning a component part of an image of an entire page **without any further restriction or limitation** is completely and totally in error. The specification not only fully supports the construction of the claim language asserted by the Applicants, but also contains no wording that would even arguably justify the Examiner's attempt to confuse the issue by engrafting a limitations directed to the separation of different types of images from one another onto the true meaning of the terms used in the presently pending claims.

***B. The Examiner has misconstrued the portions of the present specification that he has relied upon in support of his assertion that the present invention is directed to page or document images rather than to "each input image data", i.e., in the page image context component parts of so-called page or document images.***

The Examiner at page 12 of his Answer to Applicants' Brief has quoted sections of pages 44 and 53 of the present specification in support of his contention that the Applicants' images must be understood to be either so-called "page" or "document" images. Applicants respectfully submit that when appropriately understood these portions of the present specification fail to support (and if fact contradict) the Examiner's position.

A cursory examination of the specification reveals that the portion of page 44 upon which the Examiner relies discusses the so-called "Image Output Table". This is significant because the discussion set forth at that portion of the specification ***follows*** the discussion of the "Image Processing Table" (see also the discussion of the temporary memories and memories 403 and 502 in Applicants' Brief at pages 10-13).

More specifically, when the portion of the present specification from page 44 upon which the Examiner relies is taken in the context of the entire specification, it will immediately be understood that that portion of the specification is limited to the output of image information ***after*** the input request, input completion request and processing completion components of the management table function have been completed, i.e., after the "each image input data" has past the point in the sequence last covered by the claims at issue. (See, Specification, Page 44, lines 4-6 indicating that the output table manages "processed" data)

Accordingly, the fact that the output table manages the processed "each input image data" in a manner that assembles it in particular ways and combinations for output in the form of pages has nothing to do with the features herein claimed and at issue on this Appeal.

The portion of page 53 of the present specification referred to by the Examiner, on the other hand, deals with the formation of "composite" images **after** the input request, input completion and processing completion steps have been finished, i.e., at a point at which the various processed images are being assembled in a desired manner for ultimate printing in a selected format with a selected content from the processed image data available. Applicants respectfully note in this regard that a so-called "composite image" does not necessarily have to comprise a plurality of page images (the specification discloses the formation of a plurality of pages into a composite image **as an example**, but also clearly indicates that it proceeds from an image table that initially dealt with "each image inputs"). A "composite" image, therefore, might within the scope of the present specification comprise selected "each input image data" derived from one or more page images combined into a composite of portions of each of the source page images.

Again, therefore, the portion of the present specification relied upon by the Examiner has nothing to do with the features claimed and at issue on this Appeal.

Instead, the present specification clearly and definitively supports Applicants' assertion that the present invention is directed to "each input image data" in terms of input requests, input completion requests and processing completion requests. In addition, nothing that the Examiner has argued either during the prosecution of this application or in his Answer to Applicants' Brief on this Appeal concerning the appropriate construction of the term "each input image data" is sufficient to overcome the overwhelming support in the present specification and record for the position taken by the Applicants that the present invention is NOT limited to the management of image information on a page or document basis.

- C. *The only motivation present within the four corners of the art of record in this application that conceivably might have lead one of ordinary skill in the art to attempt to increase the manipulation of a management table by combining the storage and management of data with the storage of input requests, input completion requests and processing completion requests provides teachings, disclosures and/or suggestions of these component capabilities only in the context of the input and processing of complete pages/documents.***

In his Answer, the Examiner has gone to significant lengths in an attempt to establish that the Suzuki reference discloses a management table means that handles "input image data". Unfortunately for the Examiner's argument, however, this is not the point. The point is that the Suzuki reference handles input image data ***on a page or job basis, not on an "each input image data basis"***. The Examiner specifically admits this fact at page 13 of his Answer by stating the "Suzuki contains a data management table (92) ***for storing and managing page data.***"

The Examiner also asserts that the Tanaka reference contains a management table that stores an input request and input complete request. Further, the Examiner at least obliquely argues that the Tanaka management table's input request and input complete requests are handled on an individual image data basis. Again, however, the Examiner misses the point.

The point here is that Tanaka uses a management table to create what is essentially a job description file similar to that disclosed by the Suzuki reference. Accordingly, as Applicants previously explained in their Brief on Appeal and otherwise in the present record, Tanaka does not contemplate, nor does he provide any means of using, a management table for individually controlling input requests, input completion requests or processing completion requests in a manner the same as, or suggestive of, the present invention. The only way of which Applicants are aware that the Tanaka management table can be utilized in the handling of data for external use is after the so-called "small card" has been formed by the Tanaka system. In addition, and significantly, the use of that "small card" in Tanaka is based upon document output and page controls.

The Examiner's postulated combination of the Suzuki and Tanaka references therefore shows (i) a management table for storing and managing page data (Suzuki), and (ii) a management table that stores input request information and input complete information in the context of the creation of a transmission message for the transfer of that information to a so-called "small card" that in turn provides subsequent access to a network for use of the information contained therein **in the form of pages/documents only**. Clearly, this is not the same thing as, and the combination postulated does not even remotely suggest, the present invention.

Instead, the simple facts are that while the Examiner has found a reference showing the storage and management of page information on the one hand, and the use of input requests and input completion requests in the context of the creation of a transmission message for transfer to a "small card" for later use in the provision of access to the input information in page/document form by a user, on the other hand, neither of those references provides a disclosure or suggestion of the present invention within the "four corners" of the combination postulated. Specifically, neither the Suzuki nor the Tanaka reference whether taken alone or in combination with the other, discloses, teaches or suggests that the input information, whether it be page images or individual data groupings, is in any way usable other than as page/document information.

In the latter regard, attention is respectfully directed to the fact that in each case (Suzuki or Tanaka), a failure in data input at any time prior to completion of the contemplated process causes the disclosed system to return to the start of data input contrary to the teachings of this invention. In other words, a failed job description file forces it to be reloaded in Suzuki, et al. Similarly, a failed data input in Tanaka, et al. causes the iterative data acquisition scheme of that reference to fail thereby causing the formation of the transmission message then in process to be cancelled. This in turn requires the reloading of the individual information and its re-association with the other input information in the transmission message that ultimately determines the usability of the so-called "small card" to access entire pages/documents on the network.

***D. The prior art must be read as a whole, including the portions thereof that teach away from the present invention, and in that posture of the case, the Examiner must justify his rejection within the context established by the art upon which he relies.***

The Examiner asserts that hindsight is allowed to a certain extent in the examination pending claims, i.e., when "it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure". Applicants, however, respectfully submit that this statement is at least somewhat disingenuous in the present circumstances.

The law stated at page 16 of Applicants' Brief to the effect that the suggestion for the combination claimed, as well as all of its component parts, must all be present within the "four corners" of the cited art to justify the rejection applies despite the Examiner's apparent attempt to sidestep that requirement. In addition, the law cited in Applicants' Brief as establishing the fact that the Examiner has an affirmative obligation to explain his rejection in greater detail than a simple assertion that his proposed combination would "increase the manipulation of the management table" also still applies despite the Examiner's attempt to gloss over the point.

In other words, Applicants respectfully submit that the prior art must be read as a whole, including the portions thereof that teach away from the present invention. Applicants also respectfully submit that the Examiner must justify his rejections within the context established by the art upon which he relies. Hence, any attempt by the Examiner to avoid "hindsight reasoning" based upon some sort of vaguely defined alleged knowledge of those skilled in the art must be shown by something more than an "obvious to try" approach.

In other words, there must be something more present in the art than the existence of isolated components that in hindsight in view of the Applicants' disclosure are, or might be, "obvious to try". Similarly, it is improper to use the claims a framework within which to build a mosaic of isolated elements from the prior art so as to recreate the invention. Further, the Examiner cannot justifiably circumvent these well-established principals simply by generalizing that hindsight reasoning is permitted when it is based upon facts well known to those skilled in the art. Instead, the reasons supporting the proposed combination by those skilled in the art outside the scope of Applicants' disclosure must be affirmatively demonstrated if the Examiner's use of hindsight is to have any justification in his establishment of the *prima facie* case he is required to present in support of a rejection based upon 35 USC 103(a), the statutory provision relied upon by the Examiner in this application.

In the case at hand, the features of the present invention summarized in Applicants' Statement of the Invention (which the Examiner has admitted to be correct) establish that the present invention allows the transfer of information in the form of "each image input data" and/or the processing thereof to resume where it left off as a result of trouble or the like. Applicants respectfully submit (and the Examiner has not shown otherwise) that this feature of the present invention is not present in, and is not disclosed, taught or in any way suggested by the art relied upon by the Examiner.

Thus, even if the individual functions attributed to the art by the Examiner were known to those in the art at the time the present invention was made (facts which Applicants respectfully submit the Examiner has not fully demonstrated), the impetus for their combination in the manner of the present invention was not so known. In other words, the simple fact that the combination of various known functions in contexts distinct from the present invention ***might*** increase the manipulative ability of a management table such as that taught by the present specification is not a substitute for a teaching, disclosure or suggestion of the present invention within the four corners of the art. Instead, it is simply another way of saying that the present invention would be an alternative that would ***obvious to try*** to those skilled in the art. "Obvious to try", however, is well known to be an inappropriate standard for the use in a determination of patentability.

### **III. CONCLUSION**

It is respectfully submitted that for the foregoing reasons and those stated in Applicants' Brief, neither the prosecution record of this application nor the Examiner's Answer are sufficient to justify (establish the requisite *prima facie case* in support of) the Examiner's final rejections of Claims 1 - 4 and 6 - 17 of the subject application under 35 USC 103(a). Accordingly, a reversal of the currently outstanding final rejections of Claims 1 - 4 and 6 - 17 of the subject application is respectfully requested along with a remand of this application to the Examiner with instructions to allow the entry of Applicant's proposed Amendment After Final Rejection to Claims 1 and 14 as shown in Appendix II attached, and to allow this application as so amended.

Respectfully submitted,

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